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10/801,679	03/17/2004	Tomotsune Nishimura	A453-1	3334
21254 7590 07/21/2008 MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817				
EXAMINER				
JAKOVAC, RYAN J				
ART UNIT		PAPER NUMBER		
2145				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/801,679

Applicant(s)

NISHIMURA, TOMOTSUNE

Examiner

RYAN J. JAKOVAC

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-8, 10-16 and 18-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-8, 10-16 and 18-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claim 16 is objected to because of the following informalities: Punctuation is required after "... a second retriever which retrieves said moving-data stored in said second memory area". Appropriate correction is required.
2. Claim 21 is objected to because of the following informalities: The claim recites "The computer readable medium of 20, further..." The claim should recite "The computer readable medium of *claim* 20..." Appropriate correction is required.
3. Claim 20 is objected to because of the following informalities: The claim recites "wherein the program comprising executable steps to be executed by said computer..." This is taken to be a grammatical error. The claim should most likely read "wherein the program *comprises* executable steps..." Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3-8, 10-16, and 18-23 are rejected under 35 U.S.C. 102(b) as being anticipated by US 2002/0091777 to Schwartz.

Regarding claim 1, 23, Schwartz teaches a method of automatically replying to a received e-mail in a mobile terminal having a function of transmitting and receiving an e-mail, the method comprising: determining whether to automatically reply to the received e-mail (Schwartz, [0014], recipient generates reply based on predetermined criteria.); determining whether the received e-mail originates from a known address (Schwartz, [0014], recipient generates reply based on number of e-mail messages sent by a particular sender (i.e. known address).); determining whether text data is associated with the known address (Schwartz, [0014], recipient generates reply based on number of e-mail messages sent by a particular sender (i.e. text associated with the known address is the sender's email address and other text specifying response criteria associated with the known address such as the time the email was sent from the sender or the date the recipient last received an email from the sender). See also, [0029], reply messages are forwarded along with the text associated with them.); determining whether image data is associated with the known address (Schwartz, [0014-0015], a reply file is sent as an attachment in the reply message. As described in [0015], the reply file is an image file. The "image data" associated with the known address is either the reply file itself consisting of an image, or any data indicating that an image file has been attached to the reply message.); editing the image data in accordance with the known address (Schwartz, [0014], reply file generated. Reply file is disclosed to be an image file in [0015]. [0014-0015] disclose Generating a reply file (i.e. editing image data) to be sent to a known sender (i.e. in accordance with the known address).); automatically transmitting the image data determined in accordance with the known address of said received e-mail to said address if the method determines to automatically reply to

the received e-mail (Schwartz, [0011-0015], Schwartz discloses a message of automatically generating a reply message with a file (i.e. image) attachment. The reply message is sent along with the attached file according to predetermined criteria (i.e. image data is transmitted) including the number of email messages sent by a particular sender (i.e. a known address).).

Regarding claim 3, Schwartz teaches the method as set forth in claim 1, wherein said image data comprises moving-image data (Paragraph [0015] teaches the file associated with the reply message as a video file.).

Regarding claim 4, Schwartz teaches the method as set forth in claim 1, wherein text data determined in accordance with said known address is automatically transmitted together with said image data (Paragraph [0022] teaches "In keeping with the invention, the stored replies may be text, audio, graphics, video, facsimile image, or any combination thereof, or other suitable information type.).

Regarding claim 5, Schwartz teaches the method as set forth in claim 1, further comprising determining whether said image data is automatically transmitted in response to said received e-mail (Paragraph [0028] teaches "On receipt of the message at the message server 16, the message server or other electronic equipment in communication therewith, will associate the message with a specific recipient and cross reference the recipient's user profile, and in particular, both the user's reply message profile and reply file profile, to determine what, if any,

reply message or messages and attached files should be generated and the corresponding address or addresses where the reply messages and reply files should be sent.").

Regarding claim 6, Schwartz teaches a method of automatically replying to a received e-mail (Paragraph [0001] teaches "Method and system for automatically generating a message reply and file.") in a mobile terminal having a function of transmitting and receiving an e-mail (Paragraph [0003] teaches "an electronic message, whether it is a text based e-mail, a facsimile image, a video, or a voice message, is generated by a user at a computer or other suitable wired or wireless electronic device such as, for example, a personal digital assistant, a telephone, a charge coupled device (CCD), or a facsimile machine."), comprising: checking whether an address of a transmitter of a received e-mail is stored in a memory (Paragraph [0029] teaches "The automated method for generating a reply message and/or reply file to a sender includes storing 22 a reply message to a message sent having a selected recipient address and at least one sender address." Storing a reply message to a sender address inherently includes storing the sender address.); checking whether image data associated with said address is stored in said memory (Paragraph [0029] teaches "The method further includes storing 23 a reply file to be sent to the sender, preferably, but not necessarily, by attachment to the message reply." Paragraph [0015] taught the file as an image or other file type.); and editing said image data in accordance with said address (Schwartz, [0014], reply file generated. Reply file is disclosed to be an image file in [0015]. Paragraphs [0014-0015] disclose generating a reply file (i.e. editing image data) to be sent to a known sender (i.e. in accordance with the known address).); and

transmitting said image data to said address (Paragraph [0029] teaches "Finally, the method includes automatically forwarding the reply message and reply file to the sender.>").

Regarding claim 7, Schwartz teaches the method as set forth in claim 6, further comprising judging whether it is determined to automatically transmit image data determined in accordance with said address, to said transmitter (Paragraph [0028], teaches "determine what, if any, reply message or messages and attached files should be generated and the corresponding address or addresses where the reply messages and reply files should be sent.), said judging being carried out prior to said checking (In Paragraph [0028] the phrase "if any" shows that the determination of whether or not an automatically generated reply message would be sent or not is determined before it searches the storage. If the determination was made after it searched, there would be no need for Schwartz to give the scenario where the electronic message or address didn't exist in the storage.).).

Regarding claim 8, Schwartz teaches the method as set forth in claim 6, further comprising checking whether text data associated with said address is stored in said memory, wherein said text data is transmitted to said address together with said image data in said transmitting (Paragraph [0029] teaches "Finally, the method includes automatically forwarding 24 the reply message and reply file to the sender." The message, i.e. text, and the file, i.e. image, are being sent together.).

Regarding claim 10, Schwartz teaches the method as set forth in claim 6, wherein said image data comprises moving-image data (Paragraph [0015], teaches the file as being a video.).

Regarding claim 11, Schwartz teaches a mobile terminal having functions of transmitting and receiving an e-mail (Paragraph [0003] teaches "an electronic message, whether it is a text based e-mail, a facsimile image, a video, or a voice message, is generated by a user at a computer or other suitable wired or wireless electronic device such as, for example, a personal digital assistant, a telephone, a charge coupled device (CCD), or a facsimile machine."), and automatically replying to a received e-mail (Paragraph [0001], method and system for automatically generating a message reply and file.), comprising a controller for automatically transmitting image data determined in accordance with an address of a transmitter of said received e-mail (Paragraph [0014], "reply messages and reply files are stored in an associated message server or a database or other peripheral communication therewith. The recipient may generate or have generated for her a standard reply message and reply file to be sent to all electronic message senders, may select from one or more standard reply messages and files, or may generate sender-specific reply messages and files.").

Regarding claim 12, Schwartz teaches the mobile terminal as set forth in claim 11, wherein said controller edits said image data in accordance with said address (Schwartz, [0014], reply file generated. Reply file is disclosed to be an image file in [0015]. [0014-0015] disclose Generating and sending a reply file (i.e. editing image data) to be sent to a known sender (i.e. in accordance with the known address)).

Regarding claim 13, Schwartz teaches the mobile terminal as set forth in claim 11, wherein said image data comprises moving-image data (Paragraph [0015], teaches the file as being a video.).

Regarding claim 14, Schwartz teaches the mobile terminal as set forth in claim 11, wherein text data determined in accordance with said address is automatically transmitted together with said image data (Paragraph [0022] teaches "In keeping with the invention, the stored replies may be text, audio, graphics, video, facsimile image, or any combination thereof, or other suitable information type.).

Regarding claim 15, Schwartz teaches the mobile terminal as set forth in claim 11, wherein said mobile terminal comprises of a cellular phone (Paragraph [0003] teaches "an electronic message, whether it is a text based e-mail, a facsimile image, a video, or a voice message, is generated by a user at a computer or other suitable wired or wireless electronic device such as, for example, a personal digital assistant, a telephone, a charge coupled device (CCD), or a facsimile machine.")..

Regarding claim 16, Schwartz teaches the mobile terminal as set forth in claim 11, wherein said controller comprises a data processor; a first memory area for storing addresses to which an e-mail is automatically transmitted (Paragraph [0029] teaches "The automated method for generating a reply message and/or reply file to a sender includes storing 22 a reply message

Art Unit: 2145

to a message sent having a selected recipient address and at least one sender address." Storing a reply message to a sender address inherently includes storing the sender address.), a second memory area for storing moving-data to be edited by a user of said mobile terminal for each of said addresses (Paragraph [0029] teaches "The method further includes storing 23 a reply file to be sent to the sender, preferably, but not necessarily, by attachment to the message reply."

Paragraph [0015] teaches "In keeping with the invention, the reply files may comprise any suitable file including, without limitation, a text file (e.g. Microsoft Word, Corel Wordperfect, etc.), a still image (e.g. JPEG, GIF, TIFF, PICT, EPS, PDF, PNG, DCF, DPOF, FLASHPIX, etc.) an audio clip (e.g. MPEG, MPEG II, MPEG III, MPEG IV etc.), a video clip, an Internet link, etc."), a first retriever which retrieves said addresses stored in said first memory area, a second retriever which retrieves said moving-data stored in said second memory area, a third memory area for storing a message to be edited by said user (Paragraph [0028] teaches generating a message according to the stored addresses and files. Generating the message inherently includes fetching the stored information.); and a third retriever which retrieves said message stored in said third memory area (Paragraph [0029] teaches "The automated method for generating a reply message and/or reply file to a sender includes storing 22 a reply message to a message sent having a selected recipient address and at least one sender address." Storing a reply message to a sender address inherently includes storing the sender address. Additionally the stored message can be edited by adding a file to the message.).

Regarding claim 18, Schwartz teaches the mobile terminal as set forth in claim 11, wherein said controller comprises a unit for determining whether said image data is

automatically transmitted in response to said received e-mail (Paragraph [0028] teaches "On receipt of the message at the message server 16, the message server or other electronic equipment in communication therewith, will associate the message with a specific recipient and cross reference the recipient's user profile, and in particular, both the user's reply message profile and reply file profile, to determine what, if any, reply message or messages and attached files should be generated and the corresponding address or addresses where the reply messages and reply files should be sent.").

Regarding claim 19, Schwartz teaches a computer readable medium comprising a program for causing a computer to carry out a method of automatically replying to a received e-mail (Paragraph [0001], method and system for automatically generating a message reply and file.) in a mobile terminal comprising a function of transmitting and receiving an e-mail (Paragraph [0003] teaches "an electronic message, whether it is a text based e-mail, a facsimile image, a video, or a voice message, is generated by a user at a computer or other suitable wired or wireless electronic device such as, for example, a personal digital assistant, a telephone, a charge coupled device (CCD), or a facsimile machine."), wherein steps executed by said computer in accordance with said program include automatically transmitting image data determined in accordance with an address of a transmitter of said received e-mail, to said address (Paragraph [0014] teaches "reply messages and reply files are stored at an associated message server or a database or other peripheral in communication therewith. The recipient may generate or have generated for her a standard reply message and reply file to be sent to all electronic

message senders, may select from one or more standard reply messages and files, or may generate sender-specific reply messages and files").

Regarding claim 20, Schwartz teaches a computer readable medium comprising a program for causing a computer to carry out a method of automatically replying to a received e-mail (Paragraph [0001], method and system for automatically generating a message reply and file.) in a mobile terminal comprising a function of transmitting and receiving an e-mail (Paragraph [0003] teaches "an electronic message, whether it is a text based e-mail, a facsimile image, a video, or a voice message, is generated by a user at a computer or other suitable wired or wireless electronic device such as, for example, a personal digital assistant, a telephone, a charge coupled device (CCD), or a facsimile machine."), wherein the program comprising executable steps to be executed by said computer in accordance with said program, comprising: checking whether an address of a transmitter of a received e-mail is stored in a memory (Paragraph [0029] teaches "The automated method for generating a reply message and/or reply file to a sender includes storing 22 a reply message to a message sent having a selected recipient address and at least one sender address." Storing a reply message to a sender address inherently includes storing the sender address.); checking whether image data associated with said address is stored in said memory (Paragraph [0029] teaches "The method further includes storing 23 a reply file to be sent to the sender, preferably, but not necessarily, by attachment to the message reply." Paragraph [0015] taught the file as an image or other file type.); checking whether text data is associated with the known address (Schwartz, [0014], recipient generates reply based on number of e-mail messages sent by a particular sender (i.e. text associated with the known

address is the sender's email address and other text specifying response criteria associated with the known address such as the time the email was sent from the sender or the date the recipient last received an email from the sender), See also, [0029], reply messages are forwarded along with the text associated with them.); editing image data in accordance with the known address (Schwartz, [0014], reply file generated. Reply file is disclosed to be an image file in [0015]. [0014-0015] disclose Generating a reply file (i.e. editing image data) to be sent to a known sender (i.e. in accordance with the known address).); and transmitting said image data to said address (Paragraph [0029] teaches "Finally, the method includes automatically forwarding 24 the reply message and reply file to the sender.").

Regarding claim 21, Schwartz teaches the computer readable medium of 20, further comprising an executable step of judging whether it is determined to automatically transmit image data determined in accordance with said address, to said transmitter (Paragraph [0028] teaches "determine what, if any, reply message or messages and attached files should be generated and the corresponding address or addresses where the reply messages and reply files should be sent."), said judging being carried out prior to said checking (In Paragraph [0028] the phrase "if any" shows that the determination of whether or not an automatically generated reply message would be sent or not is determined before it searches the storage. If the determination was made after it searched, there would be no need for Schwartz to give the scenario where the electronic message or address didn't exist in the storage.).

Regarding claim 22, Schwartz teaches the computer readable medium of claim 20, further comprising an executable step of checking whether text data associated with said address is stored in said memory, wherein said text data is transmitted to said address together with said image data in said transmitting (Paragraph [0029] teaches "Finally, the method includes automatically forwarding 24 the reply message and reply file to the sender." The message, i.e. text, and the file, i.e. image, are being sent together.).

Response to Arguments

6. Applicant's arguments filed 05/02/2008 have been fully considered but they are not persuasive. Applicant argues in regards to independent claims 1, 6, and 20, that the cited prior art (Schwartz) does not teach "editing said image data in accordance with said address", however in paragraphs [0014-0015] Schwartz discloses that a reply file is sent as an attachment in the reply message. As described in [0015], the reply file is an image file. The "image data" associated with the known address is either the reply file itself consisting of an image, or any data indicating that an image file has been attached to the reply message. Editing the image data is generating the image data or appending the image data to the reply message as disclosed in paragraphs [0011-0015] of Schwartz.

Applicant argues in regards to independent claims 11 and 19 that Schwartz does not disclose "a controller for automatically transmitting image data", however the server as noted in at least [0015] of Schwartz is disclosed to automatically transmit the reply message including the reply file (i.e. transmits image data).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RYAN J. JAKOVAC whose telephone number is (571)270-5003. The examiner can normally be reached on Monday through Friday, 7:30 am to 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason D. Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RJ

/Jason D Cardone/
Supervisory Patent Examiner, Art Unit 2145